

### Remarks

Applicant hereby adds new claims 25-34. Accordingly, claims 1-34 are pending in the present application.

Claim 1 is objected to. Claims 3-6 stand rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 1, 2, 10, 16, and 18 stand rejected under 35 USC 102 for anticipation by U.S. Patent No 5,774,595 to Kim. Claims 3-5, 7-9, 13-14, and 17 stand rejected under 35 USC 103(a) for obviousness over Kim in view of U.S. Patent No. 4,843,630 to Catros. Claims 6 and 15 stand rejected under 35 USC 103(a) for obviousness over Kim in view of Catros and further in view of U.S. Patent No. 6,332,034 to Makram-Ebid. Claims 11 and 19 stand rejected under 35 USC 103(a) for obviousness over Kim in view of U.S. Patent No. 6,055,337 to Kim. Claims 20-23 stand rejected under 35 USC 103(a) for obviousness over Catros in view of Makram-Ebid.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to claim 1, without admitting to the propriety of the objection, Applicant has amended the claim consistent with the Examiner's request. Applicant requests withdrawal of the objection for at least this reason.

Further, Applicant has amended claim 1 to recite that individual ones of the contours are detected responsive to respective user input of a user. Claim 1 is in condition for allowance. The Office Action on pages 2-3 identifies teachings of Kim '595 which allegedly disclose the claimed limitations. As set forth in col. 2, lines 65+, Fig. 1 of Kim '595 discloses a block diagram of a contour approximation apparatus for representing a contour image of an object expressed in a video signal. The polygonal approximation 100 receives the contour image data and performs polygonal approximation processing as set forth in Fig. 1 and col. 3, lines 1-30. A second error detection block 150 calculates second error as set forth in col. 4, lines 30+. Mode selection block 155 evaluates the error and if acceptable provides the set of quantized DST coefficients from the quantization block 130 along with segment data to contour coder 165. If the error is larger than threshold TH2, the original contour segment is further segmented.

Applicant notes that the disclosed encoder of Kim '595 implements the processing from polygonal approximation 100 to contour coder 165 with no input

from a user. Accordingly, Kim '595 discloses an automated electrical circuit system which fails to teach or suggest any detecting of contours using user input let alone the claimed individual ones of the contours are detected responsive to respective user input from a user. Inasmuch as Kim '595 discloses the video encoder automatically encodes the data, there is no teaching or suggestion to modify the reference to arrive at Applicant's claimed detection of contours responsive to user input. Positively-recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, new claim 25 recites the user input is different for individual ones of the contours. The prior art fails to teach or suggest detection of contours responsive to user input which is different for individual ones of the contours as claimed. Claim 25 is allowable for at least this additional reason.

Referring to claim 3, Applicant has added antecedent basis for the predetermined function. Applicant requests withdrawal of the indefiniteness rejection for at least this reason.

Referring to claim 4, such claim stands rejected under 103 over Kim '595 and Catros. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.). The rejection of claim 4 fails to present any motivation for combining the reference teachings.

The Office Action on page 4 states that Catros used amplitudes of gradients as weights and reducing the contour detection problem to a shortest path problem. Initially, Applicant submits Catros is directed towards issues related to bridging between disjointed contour elements. There is absolutely no motivation for one concerned with video encoding of known complete boundary image data of Kim

'595 to look to the disparate Catros teachings regarding bridging of disjointed contour elements for meaningful teachings.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Kim '595 already provides teachings regarding encoding of video signals. Kim '595 provides numerous details for arriving at the output which has been encoded including analyzing contours. But for improper reliance upon Applicant's disclosure, there is absolutely no motivation for one to look to other reference teachings.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the

alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 4 is improper without the proper motivation and Applicant respectfully requests allowance of claim 4 in the next action.

According to the motivational rationale presented in the Office Action, any teachings of a secondary reference may be combined with the teachings of a primary reference if an improvement is provided. Applicant submits the *Lee* case clearly illustrates such an interpretation is improper, conclusory, and not in compliance with the MPEP for establishing a proper *prima facie* case of obviousness. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the event that claim 4 is not allowed, Applicant respectfully requests clarification of any rejection of claim 4 in a ***non-final Action***. In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a ***non-final Action*** if any claims are not found to be allowable.

Referring to claim 12, a method recites that ***respective contours are detected by analysis of said graphical image by a predetermined function and responsive to different user input for respective individual ones of the contours***. Kim '595 fails to disclose or suggest any user input during operations of the automated video encoder of Kim '595 let alone the claimed different user input for detection of respective contours. Limitations of claim 12 are not shown nor suggested by the prior art and claim 12 is allowable for at least this reason.

Referring to claim 20, *there is no motivation to combine the reference*

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*teachings and accordingly the Office Action fails to establish an appropriate prima facie obviousness rejection.* In particular, the Office Action states that Catros fails to disclose contours being associated with a scale parameter and then relies upon the teachings of Makram-Ebeid. It is stated on pages 15-16 of the Office Action that Markram discloses a method of merging regions in which each region and contour is created at. Applicants have electronically searched Makram and have failed to uncover any teachings directed to contours.

Further, it is alleged on page 16 of the Action that it would have been obvious to modify Catros to include a scale parameter to merge similar adjacent regions to aid in correctly identifying contours. Applicant disagrees. Catros is concerned with bridging disjointed ends and is devoid of any disclosure regarding regions or merging of regions as erroneously alleged in the Action. Catros is not concerned with regions and Makram is not concerned with contours. Accordingly, there is no motivation to combine the disparate scaling concerning regions of Makram with the contour teachings of Catros.

It is also stated on page 16 of the Action that there is motivation in that it eliminates the largest number of interfaces to merge adjacent regions whose intensities are practically identical. Applicants have electrically searched Catros and have failed to uncover any teachings regarding regions or merging of regions. Accordingly, the alleged motivation directed towards merging of adjacent regions whose intensities are practically identical is irrelevant and fails to provide any motivation to combine reference teachings. As set forth by the Federal Circuit in *Lee*, conclusory statements are not sufficient to establish proper motivation.

Assuming *arguendo*, even if the disparate teachings of the different references were considered to be technically combinable, there is no motivation to combine the teachings except for improper usage of Applicant's disclosure as a roadmap. Also, the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. Claim 20 is in condition for allowance for at least the above numerous reasons.

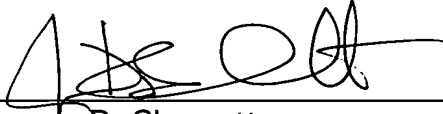
Applicants hereby add new claims 25-34. Support for the amendments and the new claims is found at least in Figs. 2-8 and the associated specification teachings of the originally-filed application.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,  
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